

AMENDMENT TO THE DRAWINGS

Please replace with the drawings with the enclosed two (2) replacement sheets showing Figs. 1 and 2 on separate sheets. Figure 3 has been canceled from this application.

REMARKS**I. Status of the Application and Claims**

Claims 1-20 are pending. Claims 2-6 have been canceled. Claim 1 is subject to examination in this application. Claims 7-20 have been withdrawn. Claim 1 has been amended to overcome the rejections under 35 USC 102. Support for the amendments to claim 1 are found in Example 1, Table (1a) – (1f) of the filed specification. Figure 3 has been canceled and the specification has been amended accordingly. No new matter has been entered.

II. Priority

A certified English-language translation of the priority document KR 2003-0000987 is enclosed herewith to perfect the Applicants' claim to priority. Therefore, Applicants believe they are entitled to the January 8, 2003 date of the priority document under 35 USC 119 (a) – (d).

III. Drawings

The Examiner has objected to Figure 3 as being too dark to read. Applicants have canceled Figure 3 and have provided replacement drawings sheets. The specification has been amended to reflect the cancellation of Figure 3.

IV. Claim Rejections Under 35 USC 102

The rejection of claim 1 under 35 USC 102(a) as being anticipated by the teaching in the publication of Kim et al. is respectfully traversed. The Examiner found Kim to generally teach a β -catenin microarray. However, Applicants have submitted a certified English-language translation of the priority document KR 2003-0000987, which was filed on January 8, 2003 to perfect their claim for priority. Accordingly, Applicants now believe the Kim reference has been antedated and should be withdrawn.

The rejection of claim 1 under 35 USC 102(b) as being anticipated by US 5,474,796 (Brennan) is respectfully traversed. The Examiner alleges that Brennan teaches an array which contains oligonucleotides with 10 nucleotides each, and the total array allegedly teaches every possible permutation. In response, Applicants submit there is no teaching in Brennan of the present invention which comprises oligonucleotides which "are those of SEQ ID Nos. 1 to 121".

To satisfy a rejection under 35 USC 102, the identical invention must be shown in as complete detail as is contained in the claim. See *MPEP* 2131. Applicants point out that Brennan only discloses one sequence which is 10 bases long, wherein each of the sequences disclosed in Applicants' specification discloses a sequence having 21 bases. Moreover, Brennan contains no explicit teaching of all 121 sequences. The Examiner's argument is premised on a general disclosure in

Brennan to show that every permutation is taught. However, there is no guidance in Brennan to show the combinations as taught by the Applicants. Applicants respectfully refer the Examiner to Brennan at column 9, lines 49- 55 which recites:

The array contains oligonucleotides having 10 nucleotides each (10-mers). The synthesis is carried out such that each oligonucleotide element, moving in a 5'-3' direction, is identical to the preceding element in nucleotide sequence, except that it deletes the 5'-most nucleotide, and adds a new 3'-most oligonucleotide. In this way the total array represents every possible permutation of the 10-mer oligonucleotide.

The permutations as alleged by the Examiner is based on the 10-mer oligonucleotide shown in Brennan. These permutations are not random, but rather follow a set of instructions wherein "each oligonucleotide element, moving in a 5'-3' direction, is *identical* to the *preceding* element in nucleotide sequence, *except* that it deletes the 5'-most nucleotide, and adds a new 3'-most oligonucleotide." [Emphasis supplied] Each obtained oligonucleotide looks like SEQ ID No. 1 of Brennan in length, but differ with respect to the 5' and 3' ends. In other words, the oligonucleotide in Brennan must be 10 bases long. Therefore, it is not possible for Brennan to teach what is claimed by the Applicants. Accordingly, because there is no teaching in Brennan of oligonucleotides which "are those of SEQ ID Nos. 1 to 121" wherein each of the sequences contains 21 bases, Applicants submit the claim is not anticipated.

The rejection of claim 1 under 35 USC 102(b) as being anticipated by El-Rifai et al. is respectfully traversed. The Examiner found El-Rifai to teach a cDNA array comprised of oligonucleotides and β -catenin. In response, Applicants submit that El-Rifai contains no teaching of the present invention which comprises oligonucleotides which "are those of SEQ ID Nos. 1 to 121". The Examiner relies on the abstract in her rejection, but a closer examination of the reference shows no disclosure of nucleotide sequences in the text, tables or figures. The cDNA used in El-Rifai is in reference to the technology, and not to the sequences themselves. El-Rifai shows tables relating to histopathology (Table I) and gene expression (Table II) and figures showing image data (Figure 1) and PCR analysis (Figure 2), but none of them teach nucleotide sequences. Accordingly, because there is no teaching in El-Rifai of oligonucleotides which "are those of SEQ ID Nos. 1 to 121", Applicants submit the claim is not anticipated by the reference.

Accordingly, it is respectfully requested that these rejections under 35 U.S.C. 102 be reconsidered and withdrawn.

CONCLUSION

In view of the foregoing amendment to the claims and remarks, it is respectfully submitted that the instant invention as defined in claim 1 is in full compliance with all the statutory requirements of Title 35 USC, and, therefore, it is earnestly requested that the Examiner's rejection be withdrawn and that the pending claim be passed to issue.

Respectfully submitted
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Dated: November 17, 2006

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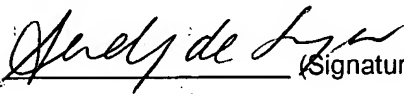
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Enclosure: Two (2) replacements sheets for drawings (Figs. 1 and 2)
Certified English-language translation of KR 2003-0000987

CERTIFICATE OF MAILING

I hereby certify that this *Amendment and Request for Reconsideration* and enclosures are being deposited with the United States Postal Service via First Class Mail addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on November 17, 2006.

Audrey de Souza (Typed or printed name of person mailing paper or fee)



(Signature of person mailing paper or fee)